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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,331	08/23/2004	Christoph Euscher	112740-995	3784
29177	7590	01/03/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC			SING, SIMON P	
P. O. BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	
			2645	
DATE MAILED: 01/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/505,331	EUSCHER ET AL.	
	Examiner	Art Unit	
	Simon Sing	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 20-24 and 30-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Paik et al. US 6,675,008.

1.1 Regarding claim 20, Paik discloses a method and apparatus for transmitting caller information to a called party (column 1, lines 10-18), comprising steps of:

storing caller picture or audio information in a network node (column 7, lines 9-24); and

outputting the caller information, such as picture information or audio information to a terminating terminal (column 5, lines 10-13; column 9, lines 26-33; column 11, lines 12-22).

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1.2 Regarding claim 21, Paik teaches storing the picture information or the audio information in picture memory 45 or audio memory 48 (figure 3) of picture service controller 40 (figure 1) (column 6, lines 20-27).

1.3 Regarding claim 22, Paik teaches storing picture information in a memory 9 of a terminating terminal (column 5, lines 41-62; column 11, lines 52-58).

1.4 Regarding claim 23, Paik teaches storing picture information in an originating terminal (column 9, lines 33-41).

1.5 Regarding claim 24, Paik teaches caller information is a combination of picture and audio information (column 5, lines 10-13; column 9, lines 29-33).

1.6 Regarding claim 30, Paik teaches a combination of picture information, audio information and character (text) information (column 9, lines 29-33; column 8, lines 47-59).

1.7 Regarding claim 31, Paik teaches character information includes telephone number, name, trade name, etc of an originating terminal user (column 8, lines 5-55).

1.8 Regarding claim 32, it is inherent that when the terminating terminal is in a silent (vibrating) mode, selected by its user, audio information is inhibited (restricted).

1.9 Regarding claim 33, Paik teaches an originating terminal selects what kind of information to transmit (column 7, lines 9-14).

1.10 Regarding claim 34, Paik discloses a terminating terminal 10b in figures 1, 2 and 5, for identifying an originating party via information received (column 4, lines 31-50; column 5, lines 41-62; column 9, lines 26-33) comprising:

a picture display unit 11 for displaying a caller picture information (column 11, lines 12-22, 52-58); and

a speaker 13 for outputting a caller audio information (column 11, lines 12-22);

1.11 Regarding claim 35, Paik teaches a memory 9 for storing caller picture information (column 11, lines 52-58):

1.12 Regarding claim 36, Paik also teaches a LCD display unit 12 for display caller character information (column 11, lines 12-22) and the character information is combined with picture information (column 5, lines 10-13; column 9, lines 26-33).

1.13 Regarding claim 37, it is inherent that when the terminating terminal is in a silent (vibrating) mode, selected by its user, audio information is inhibited (restricted).

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1.14 Regarding claim 38, Paik discloses an originating terminating terminal 10a in figures 1, 2 and 5, for transmitting user identifying information to a network device 40, which in turn transmits the user information to a terminating terminal (column 5, lines 10-13; column 9, lines 26-33), comprising inputs to accept picture information to be transmitted to the network device 40 (column 7, lines 9-14).

1.15 Regarding claim 39, Paik teaches a memory 9 for storing picture information (column 11, lines 52-58).

1.16 Regarding claim 40, Paik teaches transmitting character (text) information (column 7, lines 45-48), which can be transmitted in combination with the picture information (column 5, lines 9-13; column 9, lines 26-33).

2. Claims 20, 25, 27, 28, 34, 35, 37-39 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Kraft et al. US 2003/0083050.

2.1 Regarding claim 20, Kraft teaches a method for sending personal items from a calling terminal to a called terminal, comprising steps of:

outputting at least one personal item (information), such as a picture or a ring tone, at the called terminal transmitted from the calling terminal (para. 0002, 0033, 0035,

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0062, 0064, 0072, 0075, 0078) for identifying a caller at the calling terminal (para. 0079).

2.2 Regarding claim 25, Kraft teaches sending the personal item after a establishing a connection (para. 0035).

2.3 Regarding claim 27, Kraft teaches personal item includes a ring tone (para. 0064).

2.4 Regarding claim 28, Kraft teaches sending a ring tone as a VIP call or a family call (figure 5a, item 82 and 83).

2.5 Regarding claim 34, Kraft teaches a receiving terminal comprising means for outputting at least one personal item from a transmitting terminal (figures 1 and 2; para. 24-28, 0075-0077).

2.6 Regarding claim 35, Kraft teaches a memory for storing the personal item (para. 0079).

2.7 Regarding claim 37, Kraft teaches restricting a personal item at the receiving terminal (para. 0075).

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2.8 Regarding claim 38, Kraft teaches a receiving terminal comprising means for outputting at least one personal item from a transmitting terminal (figures 1 and 2; para. 0002, 24-28, 0033, 0035, 0062, 0064, 0072, 0075-0079).

2.9 Regarding claim 39, Kraft teaches that personal items are saved in a memory (para. 0066).

2.10 Regarding claim 41, Kraft teaches storing personal items, including image and audio (ring tones) are stored in a memory, which also stores a phone directory (para. 0029).

3. Claims 20, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Frech et al. US 6,233,325.

3.1 Regarding claim 20, Frech teaches a method for sending a caller announcement to a called terminal, comprising steps of:

announcing caller identification to a called party (column 4, lines 10-41).

3.2 Regarding claims 25 and 26, Frech teaches an audio announcement upon setting up a voice connection between a calling party and a called party (column 4, lines 26-32).

4. Claims 20 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Zahavi et al. US 6,577,859.

4.1 Regarding claim 20, Zahavi teaches playing a voice message from a calling terminal, identifying a caller, to a called terminal (column 5, line 63 to column 6, line 10).

4.2 Regarding claim 29, Zahavi teaches playing the message after a voice connection between the calling terminal and the called terminal has been established (column 5, line 63 to column 6, line 10).

5. Claims 20, 34 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Frank et al. WO 99/25107.

Frank teaches sending information from a calling terminal to a called terminal for identifying a caller, the information including personal image or a ring tone, selected by the caller (page 2, lines 11-17; page 5, lines 6-25; page 6, lines 4-31).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) US 5,875,239 (Karelwski et al) discloses a method and apparatus for displaying a caller's image or playing a caller's voice message.
- b) US 6,038,443 (Luneau) discloses a method and apparatus for announcing a caller's name.
- c) US 2003/0032414 (Melaku et al) discloses a method and system for providing a caller's image to a called party.

7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.



S. Sing

12/15/2005



FAN TSANG
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